

Application Number: 09/396,531

Group Art Unit: 3711

Filing Date: 9/15/99

Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1001

Title: Bowler's Aid

Applicants' Reply Brief

I. Response to Examiner's Answer Rejections of Claims 40-45 Under 35 U.S.C. 112, 2nd Para.

Applicants rely on the arguments made in the Appeal Brief Section VII, A, B, and C, generally and specifically to the to examiner's rejection for claims 40-45 under 35 U.S.C. 112, 2nd Para., as stated in the following Paragraphs a to e.

I.

Grounds Stated in Examiner's Answer - Rejections of Claims 40-45 Under 35 U.S.C. 112, 2nd Para. and Applicants' Reply [stated in Paragraphs a to e, below]

A. Examiner's Answer - 1st Ground

a. In claims 40 and 42, the scope of 'maximum natural force' is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective, Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently the claim is only narrative with functional recitations that fail to further limit the elements in the previously recited claims.

(This Ground of Rejection is Repeated from Final Rejection mailed 01/26/2005, page 2, lines 15 to 18)

(See examiner's answer, page 2, lines 20-23)

(See Applicants' Response given below)

Applicants's Reply to Examiner's Answer. Restated In Paragraph a. above.

Examiner's Answer, Paragraph a, above, is repeated from the 2nd Final Rejection, mailed 01/26/2005, page 2.

Applicant has responded to this ground of rejection in the Appeal Brief, Section VII., page 11, lines 12 to end, and pages 12 to 14 and page 15, lines 1 to 9, and relies on that response.

The test under 35 USC 112, 2nd Paragraph, is in part an objective determination if the claim describes the invention to one skilled in the art. The claim recitation 'maximum natural force' would be understood from its description in the specification, as stated in the Appeal Brief,

Examiner has failed to respond to appellants' facts given in support of its argument that "maximum natural force," is not indefinite.

Examiner's grounds are lacking in facts and is limited to opinion. Examiner provides no facts or reasons, connecting facts to examiner's opinion. Examiner's Answer fails to meet the Zurko standard for examination of substantial competent evidence.

Examiner's Answer - 2nd Ground

b. the term maximum . . is subjective, imprecise, and incapable of determining the metes and bounds for the claims.

(This Ground Is Repeated from Final Rejection mailed 01/26/2005, page 3, lines 26 to 27)

(See examiner's answer, page 2, lines 29-30)

(See Applicants' Response, below)

Applicants' Response to Paragraph b. above.

Examiner's Answer, see Paragraph b, above is repeated from the 2nd Final Rejection, mailed 01/26/2005, Section VI, page 3, lines 26 to 30. Applicant has responded to this ground of rejection in the Appeal Brief, Section VII., page 12, lines 2 to end and pages 13, 14, and in page 15, lines 1 to 9, and relies on that response.

The test under 35 USC 112, 2nd Paragraph, is in part an objective determination if the claim describes the invention to one skilled in the art. The claim recitation "maximum natural," would be understood from its description in the specification, with reference to the Appeal Brief,

Examiner has failed to respond to appellants' facts given in support of its argument that "maximum," is capable of objective definition. Examiner's grounds are lacking in facts and is limited to his opinion. Examiner provides no facts or reasons, connecting facts to examiner's opinion. Examiner's Answer fails to meet the Zurko standard for examination of substantial competent evidence.

Examiner's Answer - 3rd Ground

c. with respect to claim 43, one cannot determine the structure required by something that is 'adapted to spread said force . . .substantially uniformly, referring to "metes and bounds "(page 3, lines 1-3).

(This Ground Of Rejection Is Repeated from Final Rejection mailed 01/26/2005, page 3, last 3lines).

(See examiner's answer, page 3, lines 1-3)

(See Applicants' Response, below)

Applicants' Response to Paragraph c, above.

Examiner's Answer, Paragraph c, above is repeated from the 2nd Final Rejection, mailed 01/26/2005, Section VI, page 3, last three(3) lines on page 3,

Applicant has responded to this ground of rejection in the Appeal Brief, Section V, Summary of

Claimed Subject Matter, Page 1, and on Pages 2- 3 and 4, with respect to the recitations of Claim 46, 47 and 41, on Page 2, Claim s 47, and 55 on Page 4, and Claims 49, 50, 52, and 56, on Page 3.

The test under 35 USC 112, 2nd Paragraph, is in part an objective determination if the claim describes the invention to one skilled in the art. The claim recitation “adapted to spread said force . . .substantially uniformly,” would be understood from its description in the specification, with reference to the Appeal Brief,

Applicants’ have shown the recited claim elements are supported by the structure described in the specification. Examiner has failed to respond to the facts presented by Applicants in support of its argument the structure recited in the claims is adapted to spread the force substantially uniformly.

Examiner’s grounds, reciting “. . .one cannot determine . . .,” are lacking in facts and is limited to his opinion. Examiner provides no facts or reasons, connecting facts to examiner’s opinion. Examiner’s Answer fails to meet the Zurko standard for examination of substantial competent evidence.

Examiner’s Answer - 4th Ground

d. as to ‘maximum natural force,’ ball weights and bowlers are variables without defined ranges [F]urther the ‘force,’ is also a function of how a ball is delivered or thrown . . . [A]s (sic) bowler who rolls a ball straight the pins (sic), would produce different forces when he applies spin to the ball. What would be considered to be ‘substantially rigid,’ under these conditions remains indefinite.

(This Ground Is Repeated from Final Rejection mailed 01/26/2005, page 4, lines , 6 to 9).

(See examiner’s Answer, page 3, lines 4-7)

(See Applicants’ Response, below)

Applicants' Response to Paragraph d, above

Examiner's Answer, Paragraph d, above, referring to a "maximum natural force," is repeated from the Final Rejection mailed 01/26/2005, Section VI, page 4, lines 6 to 9.

Applicants have responded to this ground of rejection in the Appeal Brief, Section VII., page 12, lines 2 to end and pages 13, 14, and in page 15, lines 1 to 9, and rely on that response.

The test under 35 USC 112, 2nd Paragraph, is in part an objective determination if the claim describes the invention to one skilled in the art. The claim recitation "maximum natural force," would be understood from its description in the specification, with reference to the Appeal Brief,

Examiner has failed to respond to the facts presented by applicants' what would be a "maximum natural force," or what would be "substantially rigid," in connection with the delivery of a bowling ball. Examiner's grounds are lacking in facts and is limited to his opinion. Examiner provides no facts or reasons, connecting facts to examiner's opinion. Examiner's Answer fails to meet the Zurko standard for examination of substantial competent evidence.

Examiner's Answer - 5th Ground

e. further the limitations in a claim must be timeless. The relationship between the ball, bowler, and finger pad shield, the product it identifies, is indefinite, uncertain and arbitrary since the formula or characteristics of the product may change from time to time. Know (sic) is that bowling styles, ball weights, finger grips are prone to change, This will affect what is considered 'substantially rigid.' Therefore, these known relationships are variable over time and as such render the claim indefinite since the scope of the claim is dependent upon them (This Ground Is repeated from Final Rejection mailed 01/26/2005, page 4, lines 16 to 20). (See examiner's Answer, page 3, lines 13-17) (See Applicants' Response, below)

Applicants' Response to Paragraph e, above

Examiner's Answer, , referring to a "'substantially rigid,' is repeated from the Final Rejection mailed 01/26/2005, Section VI, page 4, lines 16-20.

Applicant has specifically responded to this ground of rejection made in the Appeal Brief, Section VII, Page 12 lines 21 to 27, and particularly on page 13, lines 1-16, and on the response above made to and rely on that response.

The test under 35 USC 112, 2nd Paragraph, is in part an objective determination if the claim describes the invention to one skilled in the art. The claim recitation of "substantially rigid," would be understood from its description in the specification, with reference to the Appeal Brief, page 13, lines 1-16, and as described in the Appeal Brief, Section V, Summary, Page 2, stating,

The rigid finger pad finger pad shield14 is made sufficiently rigid to substantially resist deformation or flexing from the force of the bowling ball. Any less rigidity would allow the finger pad finger pad shield14 to flex or deform under the force of the bowling ball, permitting a concentration of forces with the area of contact made by the finger pad shield 14 with the finger pad 16. The force which the rigid finger pad shield 14 is made to resist is within a range limited by the conventional limit of bowling ball weights and the limit of muscular skeletal development.

Applicants rely on the response made herein made above, with respect to the 4th Ground, Paragraph d, and rely on that response for their response to this ground of rejection direction to the recitation of "substantially rigid."

Examiner has failed to respond to the facts presented by applicants why the relationship between

a. the ball, bowler, and b. the finger pad shield,

in the context of the claim and the specification, is indefinite, uncertain and arbitrary on the

grounds, given by examiner,

the formula or characteristics of the product may change from time to time, and that bowling styles, ball weights, finger grips are prone to change, affecting what is considered 'substantially rigid.'

Examiner has not provided any facts or reasons to dispute the substantial competent evidence of applicants, as presented in the application or in the Declaration of Dr. Addington as to,

the "limit of muscular skeletal development," or as to the "range limited by the conventional limit of bowling ball weights."

Examiner conclusion the recitation of "substantially rigid," is indefinite, lack any substantial competent evidence, and must be vacated.

Examiner's statement "limitations in a claim must be timeless," appears to have no meaning or reference in law or fact and are not material to this appeal. While notice may be taken that time brings change, "time," has never been a rule of the patent law.

II.

Response to Examiner's Answer Rejections of Claims 33, 34, 36, 38-43, and 45-58, under 35 U.S.C. 102

A. Response to Examiner's Answer Rejections of Claims 33, 34, 36, 38-43, and 45-58, under 35 U.S.C. 102 is made generally, by reliance on the Appeal Brief Section VII, A, B, and D, and of Claims 35, 37, 44, and 57, under 35 U.S.C. 103, is made by reliance on the Appeal Brief, Section VII, A, B, and E.

B. Response to Examiner's Answer Rejections of Claims 33, 34, 36, 38-43, and 45-58, under 35 U.S.C. 102 is made specifically to arguments in the Answer, as follows.

1. For Examiners Answer, “[A]s to claim 33,” (see Page 3, line 20), starting with Claim Rejections - 35 USC §102 on Page 3 and extending to Page 4, lines 4, Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 1, and specifically on Page 18, line 6 to the Page 20, line 1.

2. For Examiners Answer, “[A]s to claim 34 and 36 . . .,” (see Page 4, lines 4-5), Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 1, and specifically on Page 20, line 2 to line 18.

3. For Examiners Answer, “[A]s to claim 38, 39, 45 and 53 . . .,” (see Page 4, lines 5 to 6), Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 1, and specifically on Page 22, line 16, starting with the *indent ed paragraph* reciting, *inter alia*, “Examiner’s grounds of rejection is the statement . . .” to Page 23, line 1.

Examiner relies on the statement,

strap **a** or **d**, is capable as (sic) functioning as a “limit means,” and is considered a “raised when the limitations in the claim are given their broadest reasonable interpretation.”

Claims 38, 39, and 45, are structure claims. To stand rejected as anticipated by Fowble, it must be shown that each of the recited claim elements are fully disclosed in Fowble. Examiner’s statement of “is capable,” and “is considered,” are statement of examiner’s opinion without record facts to support the stated “capability,” or “considered,” structure. This statement is not supported by substantial competent evidence and fails the Zurko standard for examination.

Claim 53 is a means claims means plus function claims made under 35 U.S.C. 112, 6th Paragraph. Examiner has not show any facts in Fowble performing the function recited in claim 53.

4. For Examiners Answer

“[A]s to claim 40, 41, 46-48, 54, 55 and 57, the preamble and paragraph a) are considered shown for the reasons discussed above with respect to claim 33,”

(see Page 4, lines 6 to 8),

Applicants rely on the Paragraph s A, and B. 1, above.

5. For Examiners Answer, “[A]s to paragraph b) claims 49, 50, 52, and 56, . . .” (see Page 4, lines 8 to 10), Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 1, and specifically on Page 23, lines 2 to 25.

6. For Examiners Answer, “[A]s to claim 42 and 51, “ (see Page 4, lines 10 to 17), Applicants rely on the Appeal Brief, generally, from the bottom of Page 18, line 6 to page 25, line 1, and specifically on Page 21, lines 17 to 24, and Page 23, lines 16 to 25, Page with respect to “Inherency.”

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and it would be so recognized by a person of ordinary skill.’ ‘Inherence may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ In re Robertson, 169 F. 3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The recitation of claim 51 is parallel to claim 42, with claim 51 recited as a means plus function

7. For Examiners Answer,

“[A]s to claim 43, . . . claims 46-56 and 58 . . . 46, 48, 51 . . . (claims 49, 50, 52 and 56) . . . (claim 47), . . . (Claim 55),” Page 4, lines 17 to 23,

Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 16, and specifically to Page 23, last two (2) lines and Page 24, lines 1 to 9, and to Page 23, lines 16 to 25, Page with respect to “Inherency.” (see Page 4, lines 18 to 23),

8. For Examiner's Answer stating ,

“Fowble meets the limitations of . . . Claims must be interpreted given their broadest possible meaning . . . , A piece of paper ‘resists deformation of any force applied to its up to a certain point,”

(see Page 4, lines 24 to end and Page 5, lines 1 to 3),

Applicants rely on the Appeal Brief generally, from the bottom of Page 18, line 6 to page 25, line 16, and specifically, Appeal Brief, Section V. A. Summary of Claimed Subject Matter, “For dependent claims 39, Page 3, and Section VII, Section A. Argument, Page 4 to Page 9, and Section VII. A. 2, Page 7, referring to the Manual of Patent Examination §2131 Anticipation.

35 USC 102 requires each and every element recited in the claim must be shown to exist in a single embodiment or publication. It is not enough for examiner to talk about “broadest interpretation.” Examiner is required to show how the “broadest interpretation of a particular prior art element reads on a corresponding recited claim element. Examiner has not shown by record facts, the “broadest interpretation of any element of Fowble is the same as any claimed element in Claim 33 or in any of the other rejected claims..

9. Examiner has misapplied 35 USC 102.

See Answer, Page 4, lines 24 to end and Page 5, lines 1 to 3.

35 USC 102 is a fact standard. Fowble's facts are not inclusive of the claim elements recited in any of the claims including claims 38 and 39. See Paragraph B., 3, above.

Examiner's reliance on Inherency, is misplaced. Inherency must be made clear by extrinsic evidence the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. See *In re Robertson*, 2 169 F.3d 743, 745, USPQ2d 1949, 1950-51 (Fed. Cir 1999).

III.

Response to Examiner's Answer Rejections of Claims 35, 37, 44, and 57, under 35 U.S.C. 103.

Applicants rely on the Appeal Brief, Section 7, Subsection E, Page 24, line 13 to Page 26, line 3.

IV.

Response to Examiner's Answer (10) Response to Argument

Examiner's "Response to Argument," (see pages 5 to 12), is cumulative to examiner's response made specifically under 35 USC 112, 35 USC 102 and 35 USC 103. Applicant applies all of the response made above, with regard to the following examiner stated grounds, as follows.

a. "Maximum natural force" and "substantially rigid under 35 USC 112, 2nd Paragraph (see Answer, page 6, lines 10 to end, page 7, lines 1 to 17);

Applicants' response applied to this ground is the same as made above in Section I, and in the Appeal brief, Page 11, line 12, page 13, 14, and page 15, lines 1 to 9, the same as if rewritten herein, in its entirety.

Examiner's argument is "the definition of a term cannot depend on an undefined standard." (See page 7, line 15.) However, claims are read in connection with the description of the invention given in the specification and claims are read as a whole. While respective claim elements may be indefinite, the standard of examination requires substantial competent evidence demonstrating that in the context of the description and in the claim as a whole, a claim element is indefinite, in this case in examiner's opinion that it depends on an "undefined standard." (see Page 7, line 15).

Examiner has not shown by substantial competent evidence, that "maximum natural force," is not defined sufficiently for one skilled in the art to understand, make, and practice, the claimed invention.

Claims 44 to 58 are means plus function claims and examiner has not shown by substantial

competent evidence, the functions are indefinite.

b. Declaration of Dr. W. Robert Addington (see Answer, page 7 lines 18 to 24, page 8, lines 1 to 12);

Applicants' response made in the Appeal Brief, page 14, and page 15, lines 1 to 26, is incorporated herein, the same as if rewritten in its entirety.

Dr. Addington is a joint inventor. Dr. Addington is an expert and he is entitled to rely on what is known and understood as reliable standards. The Declaration is a statement of facts. Dr. Addington's Declaration of facts is entitled to be considered with full credibility without a demonstration by substantial competent evidence, the facts are contrary to what is acceptable to the relevant scientific community or irrelevant to the recited claimed invention.

Examiner has not shown by any substantial competent evidence that any part of Dr. Addington's Declaration is incorrect, or an opinion contrary to medically accepted facts.

c. What Fowble discloses (see Answer, page 8, lines 13 to end; page 9, lines 1 to 15);

Applicants' response made in the Appeal Brief, page 15, lines 27 to end, page 16, page 17, and page 18, lines 1 to 5, are is incorporated herein, the same as if rewritten in its entirety.

What is disclosed in Fowble is a fact determination which must be supported by substantial competent evidence. Examiner cannot rely on what a Fowble element "inherently," does (see Answer, Page 8, last line). Examiner cannot rely for grounds for rejection under the fact standard of 35 USC 102, that applicants,

". . . have done nothing to show that element 'a' of fowble (sic) done not possess (sic) trhe characteristics function of being able to limit the insertion of Fowble's insert into a bowling ball."

It is for examiner to show factually in Fowble, by substantial competent evidence, each of the

recited elements of the claimed invention. Examiner has not met that standard.

d. Whether the facts show the claimed and recited elements are anticipated by Fowble (see Answer, page 9, lines 16 to end, page 10, page 11, lines 1 to 18);

Applicants' response made in the Appeal Brief, page 18, lines 5 to end, pages 19 to 23 and page 24, lines 1 to 5, are incorporated herein, the same as if rewritten in its entirety.

There is nothing new in this statement by examiner. Examiner repeatedly relies on a *sui generis* application of "Inherency," that is not what is understood as Inherency under law. (See Appeal Brief, page 8, lines 18 to 23).

e. Whether the facts and law show the claimed invention is obvious in view of Fowble and Pratt (see Answer, page 11, lines 19 to end .

Applicants' response made in the Appeal Brief, page 24. Line 13 to end, pages 25 to 26, and page 27, lines 1 to 3.

Applicant believe each and every ground of rejection made in the Final Rejection and in the Answer has been rebutted.

Examiner has substantially repeated the grounds given in the Final Rejection, in the Answer. In the event, each and every ground in the Answer is not specifically addressed in this Rely, applicants believe the relevant grounds are in the Appeal Brief.

Respectfully,

/joelirosenblatt/

Joel I. Rosenblatt

Attorney for Applicants